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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARY ELIZABETH HAMILTON, MICHAEL A. HOLZMAN,
LOIUS CHARLES NEBOLSKY, and ATUL K. KAPUR

Appeal 2015-002696
Application 12/537,830
Technology Center 3600

Before ANTON W. FETTING, BIBHU R. MOHANTY, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–24, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to electronic collaboration tools and applications (Spec., para. 1). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An electronic collaboration enablement system, comprising:
 - a processor;
 - a memory coupled to the processor, the memory comprising:
 - multiple project templates, where each project template corresponds to a different project type and comprises:
 - an identification of phases associated with the corresponding project type;
 - an identification of a set of activities associated with each phase; and
 - an identification of project management electronic collaboration tools associated with the corresponding project type and with each phase of the corresponding project type and with each activity of the corresponding phase; and
 - instructions that, when executed, cause the processor to:
 - receive a first project type identifying a project to be performed;
 - receive provisioning data associated with the first project type;
 - identify a first project template from among the multiple project templates that corresponds to the first project type;
 - identify, from the first project template, a set of phases corresponding to the first project type, the set of phases comprising a first phase and subsequent phases, wherein the set of activities associated with the first phase comprises a first activity and subsequent activities;
 - integrate collaboration tools identified in the first project template as corresponding to the first phase of the first project type and a first activity of the first phase into a single electronic collaboration user interface;
 - customize the electronic collaboration user interface to the first activity and the first phase of the project to be performed;
 - identify when the project has moved to one of the subsequent activities of the first phase or to one of the subsequent phases of the first project type;

dynamically identify and integrate the project management electronic collaboration tools corresponding to each subsequent activity of the first phase and to each subsequent phase into the electronic collaboration user interface when the project moves to the subsequent activities or subsequent phases, respectively; and

dynamically customize, as the project moves to one of the subsequent activities of the first phase or one of the subsequent phases of the first project type, the electronic collaboration user interface to each subsequent activity of the first phase and to each subsequent phase of the first project type, respectively.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–24 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1–6, 9–14, and 17–22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Frisco et al. (US 2003/0061330 A1; Mar. 27, 2003), Wolff (US 2004/0143477 A1; July 22, 2004), and Wodtke et al. (US 2005/0027585 A1; Feb. 3, 2005).
3. Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Frisco, Wolff, Wodtke, and Franklin (US 2005/0095569 A1; May 5, 2005).
4. Claims 5, 6, 13, 14, 21, and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Frisco, Wolff, Wodtke, and Beaven et al. (US 2004/0186762 A1; Sept. 23, 2004).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence.¹

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 101 is improper because the claim is not directed to an abstract idea, and that even if the claim is directed to an abstract idea that the claim defines “significantly more” to overcome the rejection (Reply Br. 2–12).

In contrast, the Examiner has determined that the rejection is proper (Ans. 2–9).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “laws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the

¹ *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* This is a search for an “inventive concept” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we find that the claim is directed to the concept of managing project templates for a project team. This is a fundamental economic practice long prevalent in our system of commerce and is a method of organizing human activities, and is an abstract idea beyond the scope of § 101.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Here, the claim is not rooted in technology but rather the concept of managing project

templates for a project team, which is an abstract idea for the reasons given above.

We note the point about pre-emption. Reply Br. 6. Although pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012))), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). See also *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015), cert. denied, 136 S. Ct. 701, 193 (2015)(“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

For these reasons the rejection of claim 1 is sustained. The Appellants have presented the same arguments for the remaining claims and the rejection of these claims is sustained as well.

Rejection under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitation to:

dynamically identify and integrate the project management electronic collaboration tools corresponding to each subsequent activity of the first phase and to each subsequent phase into the electronic collaboration user interface when the project moves to the subsequent activities or subsequent phases, respectively

(Claim 1).

In contrast, the Examiner has determined that the rejection is proper and that the cited claim limitation is found in Frisco at Figures 8, Fig. 14A,

and Fig. 14B (Ans. 10–3). The Examiner also makes citations to Frisco at Figures 9, 12A, 13, 14A–C, 15A–C, 16A-C, 20, 20A, 22, 23, 25, 26, and paras. 36, 37, 62, 63, 241, 242, and 255–257 (Ans. 13–15).

We agree with the Appellants. Here, the cited claim limitation is not shown by Frisco at Fig. 8, Fig. 14A, and Fig. 14B. These cited portions fail to specifically disclose the argued claim limitation. For example in Fig. 8, the figures do show dynamic field (tools) for an activity. However it is not specifically disclosed that these tools are “integrat[ed]...into the user interface” when the project moves to the “subsequent activities or subsequent phases respectively” as claimed. The other above cited portions of Frisco fail to disclose this claim limitation as well. For these reasons, the rejection of claim 1 and its dependent claims is not sustained. The remaining claims contain a similar limitation to one listed above, and the rejection of these claims is not sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101 as listed in the Rejections section above.

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as listed in the Rejections section above.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

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Application 12/537,830

DECISION

The Examiner's rejection of claims 1–24 is sustained.

AFFIRMED